AF/1642

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PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

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Total Number of Pages in This Submission	14

Application Number	**08/644,289**
Filing Date	**May 10, 1996**
First Named Inventor	**Molly F. Kulesz-Martin**
Group Art Unit	1642
Examiner Name	M. Davis
Attorney Docket Number	RPP:135D US

ENCLOSURES (*check all that apply*)

- ☒ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers (for an Application)
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☒ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please identify below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	**Michael L. Dunn** **Dunn & Associates**
Signature	Michael L. Dunn
Date	June 04, 01

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: June 01, 01

Typed or printed name	**Michael L. Dunn**		
Signature	Michael L. Dunn	Date	June 4, 01

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FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT ($)

Complete if Known	
Application Number	08/644,289
Filing Date	May 10, 1996
First Named Inventor	Molly F. Kulesz-Martin
Examiner Name	M. Davis
Group Art Unit	1642
Attorney Docket No.	RPP:135D US

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number: **04-1790**

Deposit Account Name:

☒ Charge Any Additional Fee Required Under 37 CFR 1.16, 1.17, 1.18 and 1.20

☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☐ **Payment Enclosed:**

☐ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	$
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES

		Extra Claims		Fee from below		Fee Paid
Total Claims	-20** =		X		=	$
Independent Claims	-3** =		X		=	
Multiple Dependent					=	

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examination action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) ($)

SUBMITTED BY

Name (Print/Type)	Michael L. Dunn	Registration No. (Attorney/Agent) 25,330	Complete (if applicable) Telephone	716-433-1661
Signature	Michael L. Dunn		Date	June 04, 01

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RPP:135D US

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants:	Molly F. Kulesz-Martin	Art Unit:	1642
Serial No:	08/644,289		
Filed:	May 10,1996		
Examiner:	M. Davis		
For:	p53as PROTEIN AND ANTIBODY THEREFOR		

I certify that this **REPLY BRIEF** is being deposited on **June 4, 2001** with the U.S. Postal Service as first class mail addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231

Michael L. Dunn
Registration No. 25,330

REPLY BRIEF

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in reply to the Examiner's Answer dated May 24, 2001.

Many of the arguments raised by the Examiner are refuted by the original Brief on Appeal; however, a number of arguments in the Examiner's Answer are new or expanded.

The Examiner's statement that the brief does not contain a statement with respect to related appeals and interferences is not correct. The required statement is clearly given at the bottom of page 1 of the Brief.

The Examiner's statement with respect to grouping of claims is not agreed with and in any case is irrelevant. The Appellant has given reasons why the claims do not stand or fall together and why the claims may be considered independently patentable over the cited art. It is

thus the province of the Board, not the Examiner, to determine patentability of the claims and it is the province of the Board, not the Examiner, to determine whether the cited art applies (or does not apply) to the claims equally.

The Examiner's argument with respect to indefinite nature of the language "active wild type", in Claims 1, 3-6, 8-11, 17 and 18, disregards clear claim limitations that the activity referred to is "growth regulation". The Examiner may not broaden the claim language beyond its clear limits and then say that the broadening done by the Examiner is indefinite.

The Examiner's argument with respect to the "new matter" rejection of Claims 1, 3-6, 8-11, 17 and 18 is flawed for reasons similar to the above. Again the Examiner improperly interprets the claims beyond its clear limits and then says that the misinterpretation encompasses new matter. The claims clearly require that the claimed p53as be the same as p53 up to the final 50 carboxy terminal amino acids of p53. Any differences between p53 and p53as thus may not be before the final 50 carboxy terminal amino acids of p53. Despite this clear limitation, the Examiner says that the claims encompass new matter because an epitope different than p53 could be anywhere in p53as. That interpretation is illogical and is simply not possible and must disregard the clear requirement of identity up to the final 50 amino acids.

It has always been the position of the Appellant that the unique epitope in the p53as of the invention was there to distinguish p53as from p53. For the first time in the Examiner's answer, the Examiner has raised an argument that there is no disclosure in the specification that the epitope be unique with respect to all proteins. **This is a new argument first presented in the Examiner's Answer and as such is an untimely new ground of rejection that should be**

presented as such to permit amendment. No amendment in reply to the final rejection made any changes to the claims that would affect the nature of this new argument. The new argument therefore was not made necessary by any action on the part of the Appellants. In any case it is the position of the Appellants that the "unique epitope" referred to means unique as between p53 and p53as and has always been argued as such. Whether or not the epitope is unique as to all other proteins is essentially irrelevant with respect to the invention since the point is to distinguish between p53 and p53as.

In any case, as previously discussed in the brief and throughout prosecution, one skilled in the art, once given motivation by the present application, can easily add epitopes to the end of p53as to distinguish from p53. There is no new matter. If, however, the Board agrees with the Examiner that there is new matter, it is requested that a formal new rejection be given so as to allow the Appellants to amend.

The arguments made by the Examiner with respect to the art rejections have already been addressed in the brief. It is sufficient to simply reiterate that these rejections are classic hindsight. The references, no matter haw they are combined simply do not suggest the invention. As an example, the Examiner uses classic hindsight logic by stating that because Han et al teaches that a part of a p53as (clearly not functional) in a plasmid for the purpose of study renders it obvious to incorporate a complete p53as into a plasmid for use as a vector. This is a clear quantum leap unsupported by the cited art. The Examiner makes an attempt to support such a position by saying that full length sequences for proteins other than p53as have been incorporated into plasmids for study and somehow that makes it obvious to incorporate a

sequence for a different (p53as) into a plasmid, not even for study, but for use as a vector. Such an argument is clearly improper.

In summary, none of the references cited by the Examiner in any of the rejections suggest incorporating p53as into anything and certainly not into a plasmid or viral vector. None of the cited references have this critical defect cured by anything disclosed in any of the other cited references.

The rejections should be reversed.

Conclusion

In view of the foregoing, it is clear that the pending claims are definite, contain no new matter and are patentable over the cited prior art. Reversal of the Examiner and allowance of all claims are therefore respectfully requested.

Respectfully submitted,

Dated: June 4, 2001

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